

REMARKS

The Office Action dated September 3, 2009 has been received and its contents carefully noted. In response thereto, applicant has amended the specification, drawings and claims in an effort to place the application in condition for allowance. New dependent claims 25-26 have been added. Reconsideration of the rejections of the claims is respectfully requested in view of the foregoing amendments and the following remarks.

Drawings

Applicant submits herewith a proposed amendment to Sheet 1 of the drawings. The proposed drawing amendment changes the lead line for reference numeral 2 in Fig. 1 as shown on the attached "Replacement Sheet". Approval and entry of the enclosed replacement drawing incorporating the proposed drawing amendment is respectfully requested.

Specification

It was noted that a word in the PCT specification was incorrectly translated from the Swedish priority application. The specification has been amended to correct the incorrectly translated word on page 3, line 25. Since the drawings clearly show the steel tube 6 "in line with" rather than "in contact with" the surface of the head 3, the amendment is believed not to add any new matter to the application. The spelling of "millimeter" was also corrected in this paragraph.

Claim Rejections - 35 U.S.C. 112

Claims 16, 21 and 24 have been rejected on the grounds of indefiniteness because it is allegedly unclear how the metal sleeve 6 can cover the viscoelastic material while the viscoelastic material is the sole contact with the manufacturing machine. Independent claim 13 has been amended to clarify that “the cutter” which is “arranged on the head (3) is isolated from the manufacturing machine via the viscoelastic material (4) ” and “those parts on a surface of the shaft (2) that are intended to be in contact directly or indirectly with the manufacturing machine are provided with the viscoelastic material (4).” Claims 16, 21 and 24 have been amended to clarify that the “metal tube (6) is arranged coaxially external to the viscoelastic material (4)” and is intended to “provide an indirect contact between the viscoelastic material and the manufacturing machine.” It is respectfully submitted that these changes correct any alleged indefiniteness and the Section 112 rejection should be withdrawn.

Claim Rejections - 35 U.S.C. §§ 102 and 103

With regard to the rejections under 35 U.S.C. §§ 102 and 103, claims 13, 14, 16, 21 and 24 have been rejected as being completely shown by JP 2003-62758. Claims 15, 17-20, 22 and 23 have been rejected as being obvious when JP 2003-62758 is combined with Seshimo (U.S. Patent No. 4,759,428). Applicant respectfully disagrees with these rejections for the following cogent reasons.

Referring to independent claim 13, it is noted that JP 2003-62758 is directed to damping vibrations in a rotary tool utilizing various materials whereas the present invention utilizes a cutting tool shown in Figure 1 with "viscoelastic material (4) arranged on at least one of the shaft (2) and head (3) such that the cutter arranged on the head (3) is isolated from the manufacturing machine via the viscoelastic material (4), in which at least those parts on a surface of the shaft (2) that are intended to be in contact directly or indirectly with the manufacturing machine are provided with the viscoelastic material (4), the viscoelastic material (4) attached on a bearer material attached to the surface of the shaft (2)." The configuration of the present invention offers important advantages over JP 2003-62758 from a manufacturing and functional point of view.

The dependent claims such as claims 15 and 25 show further features not shown in JP 2003-62758, e.g. , the viscoelastic material being divided into plates applied on the shaft. These further dependent claims specify a tool holder which, inter alia, can be easily manufactured and offers superior isolation of the cutter from a vibration point of view. Thus, the invention as specified in these dependent claims is new and novel with respect to JP 2003-62758.

The Examiner recognizes some of the inherent deficiencies of JP 2003-62758 and attempts to correct them by scouring the prior art and combining JP 2003-62758 with bits and pieces of Seshimo (U.S. Patent No. 4,759,428). However, this added reference does not make up for the above noted basic deficiencies in JP 2003-62758 so the combination proposed by the Examiner still falls far short of the present invention. In particular, the purpose of the

viscoelastic damper of Seshimo is to “control vibrations of a structural member, a tank, a pipe, etc. which may be caused by an earthquake or wind while producing minimum reaction force when the structural member and so on is slowly displaced as a result of the thermal deformation of the member itself or another member connected thereto.” See the abstract of Seshimo. Consequently, Seshimo is based on the fact that slow vibrations with low frequency are acceptable but vibrations of high frequency are damped. The objects of Seshimo is to provided a favorable viscoelastic damper making use of dilatant liquid and to provide a viscoelastic damper which presents very little resistance to low-speed motions and provides an effective damping effect to high-speed vibrational motions. In the present invention, it is important to provide resistance to motions for all frequencies and amplitudes.

It is respectfully submitted that the damping of vibrations from earthquakes, etc. as found in Seshimo has little to do with the tool holder of JP 2003-62758 or even that of the present invention. Seshimo and JP 2003-62758 are from completely different fields of technology. The artisan of ordinary skill would not be looking to Seshimo to solve the problems for providing an effective dampening mechanism in a tool holder such as found in JP 2003-62758. Thus, it is not seen how the claimed invention can be derived from Seshimo being combined with JP 2003-62758.

The addition to JP 2003-62758 of the teachings of Seshimo also falls far short of the present invention as these references, alone or in combination, simply do not teach or suggest what is set out in the applicant's claims and do not provide the basis for developing the invention to persons having ordinary skill in the art to which the subject matter pertains. Accordingly, the

Examiner's reliance on these prior art references is not properly grounded and the rejections based thereon should be withdrawn.

In addition, it is only when the Examiner looks to applicant's own disclosure that the Examiner can allege obviousness by choosing these bits and pieces of the prior art references and then combining these bits and pieces together based on alleged obviousness. Such rejections are merely improper hindsight reconstruction of applicant's own invention using applicant's own disclosure.

Accordingly, it is submitted that the present invention as claimed is readily distinguishable from the prior art references for the reasons indicated. Applicant's invention is not disclosed by any of the prior art and there is no fair basis for alleging that applicant's invention is obvious in regard to such prior art. If the invention was obvious, it would have been adopted before in view of its advantages. As it appears as though the rejections based on of JP 2003-62758 and Seshimo are incorrect, they should be withdrawn.

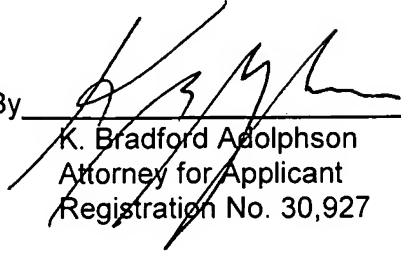
Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable and early favorable action is earnestly solicited. The Examiner is invited to call applicant's attorney if any questions remain following review of this response.

Respectfully submitted,

Dated: JANUARY 4, 2010

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